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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,180	08/27/2003	Jay S. Walker	98-076-C1	5244
22927	7590	11/14/2006	EXAMINER	
WALKER DIGITAL 2 HIGH RIDGE PARK STAMFORD, CT 06905			PIERCE, WILLIAM M	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/649,180

Applicant(s)

WALKER ET AL.

Examiner

William M. Pierce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/28/06.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-13, 15-21, 23-27 and 29-34 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-3, 5-13, 15-21, 23-27 and 29-34 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**WILLIAM M. PIERCE**  
**PRIMARY EXAMINER**

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

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#### **DETAILED ACTION**

##### ***Claim Rejections - 35 USC § 102***

Claims 1-3 5-11 13 15 16 17 18-21 23-27, 29-34 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Riendeau 6,761,633 whose, based on his provisional application, has an effective filing date of 6/2/2000 as set forth in the previous office action.

##### ***Claim Rejections - 35 USC § 103***

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riendeau in view of Sultan 6,273,817 as set forth in the previous office action.

##### ***Response to Arguments***

Applicant's arguments filed 9/28/06 have been fully considered but they are not persuasive.

The 112, 1<sup>st</sup> paragraph rejection has been overcome in view of applicant's remarks

Examiner's grounds for rejection is not based on the fact that claim 1 is a "product by process" claim.

Examiner has interpreted claim 1 as being a product by process claim in applying the prior art. While applicant states at the bottom of pg. 14 that this claims "is clearly a method or process claims". He does not state a method of doing what? Playing a game? Making a game card? Both the examiner and applicant agree that it is a process claim. Based on the steps recited therein it is a product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made. In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973); In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969); In re Steppan, 394 F.2d 1013, 156 USPQ 143 (CCPA 1967). Claim 1 recited "causing a plurality of symbols to be printed...", i.e. printing a plurality of symbols in a play area of a lottery ticket and "each link being printed", i.e. printing each link. Such are clearly product by process steps. The remaining limitations are "wherein" functional recitations. Perplexingly at the top of pg. 15 applicant admits that "although performing the steps of Claim 1 may result in a product....", in the same breath while arguing it is not a product by process. Clearly this argument is not persuasive and the examiner's grounds for rejection remains. Note that product by process claims are not limited to the manipulations of the recited steps, only to the structure implied by the steps. MPEP 2113. As such the limitations drawn to the "game rules" do not distinguish over the prior art.

As to claims 1, 8, 9, 10, 17 and 18 in view of Riendeau the previous grounds for rejection remains since "a game rule" does not distinguish over the applied art in terms of structure implied by the recited steps. As set forth

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above, these claims are not directed to a method of playing a game. The are directed to a product formed by printing steps. Inherently, in Riendeau "any one of the plurality of play symbols...is selectable" meeting the limitations of the claims.

As to claims 19 and 26, applicant argues limitations which are not present in the claims (i.e. "nodes in the play area" and "spanning the play area" . As such this argument is unpersuasive.

With respect to claims 2 and 11, most broadly, something that is "void" by definition is "being without something specified". In Riendeau the negative symbols can be considered "void" of a positive number meeting the limitations of the claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.

  
**WILLIAM M. PIERCE**  
**PRIMARY EXAMINER**